

REMARKS

Claims 34-48 have been amended. Claims 1-76 remain in the application, although claims 23-32 and 49-76 have been withdrawn from
5 consideration as a non-elected group. Further examination and reconsideration of the application, as amended, is hereby requested.

A petition for a one month extension of time accompanies this
10 Amendment.

In response to the objections to informal Figs. 5-12 of the drawings of
July 23, 1999, formal drawings are submitted herewith.

Applicants reaffirm the election of Group II claims 1-22 and 33-48.

15 In Sections 6 and 7 of the Office Action, the Examiner rejected claims 34-48 under 35 USC §101 as being directed to non-statutory subject matter. In response to this rejection, Applicants have amended claim 34 in a manner very similar to that suggested by the Examiner as a way to overcome this
20 rejection. Specifically, Applicants have clarified that the monitoring step is performed "electronically" by a "document server".

In Sections 8-9 of the Office Action, the Examiner rejected claims 1-3,
12-15, and 33 under 35 USC §102(e) as being anticipated by Griebenow.

25 Applicants respectfully traverse this rejection for the reasons stated below.

Griebenow discloses a method and system for distributing an electronic publication. As can be seen by looking at Fig. 6 of Griebenow, step 102 operates to "Deliver Publication Via E-Mail". The next step, step 104, simply
30 says "End". There is no teaching in Griebenow that the electronic publication is printed after it is delivered to e-mail. Griebenow does not disclose, teach, or suggest Applicants' claimed steps of "transmitting the document to the printing device;" and "causing automatic printing, without user intervention, the document on the printing device." Therefore, the rejection of claim 1 over

Griebenow is improper and should be withdrawn, and claim 1 is patentable over the art of record.

Claims 2, 3, 12-15, and 33 all depend on claim 1, shown above to be patentable over Griebenow. Therefore, they are also patentable over Griebenow. In addition, a subset of these claims contain additional limitations that form an independent basis of patentability over Griebenow. For example, claim 3 claims the following additional limitation: "responsive to causing printing of the document on the printing device, updating the user profile." As previously stated, Griebenow does not disclose that the electronic document is printed after it is delivered. Therefore, there is no disclosure, teaching or suggestion in Griebenow that the user profile is updated "responsive to causing printing", as Applicants are claiming. Claim 15 contains similar limitations. Claims 1, 2, 3, 12-15, and 33 are all patentable over Griebenow.

In Section 10 of the Office Action, the Examiner rejected claims 4-11, 16-22, and 39-42 over Griebenow in view of Logan. Applicants traverse this rejection. Claims 4-11 and 16-22 are all dependent on claim 1, shown above to be patentable over Griebenow. Therefore, claims 4-11 and 16-22 are also patentable over Griebenow in view of Logan. In addition, a subset of these claims contain additional limitations that form an independent basis of patentability over Griebenow. For example, claim 5 contains the additional limitation of "sending a print consumable to the user". Logan discloses the distribution of an audio program to a user, which may include advertising materials that the user can listen to to get credits off of the subscription fee. While Logan also discloses the optional distribution of a text document to a user, Logan fails to disclose, teach, or suggest anything about printing, and therefore particularly fails to disclose, teach, or suggest "sending a print consumable to a user", as Applicants are claiming. Applicants' claims 6, 7, 8, 9, 10, 11, 17, 18, 19, 20, 21, 22, 39, 40 and 41 also contain limitations related to printing and are therefore also independently patentable over the art of record.

Applicants' Claim 42 claims that "the product in the subsidizing step is a subscription". Applicants note that Logan discloses subsidizing a subscription. But Logan's subsidy is earned by a user listening to an audio file containing advertising materials, not by "electronically monitoring by a document server the usage of a printing device", and by "subsidizing the purchase of a product, based on the electronically monitoring step", and Applicants are claiming in claim 34, upon which claim 42 depends. Accordingly, claim 42 is also patentable over the art of record.

Applicants believe their claims as amended are patentable over the art of record, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02. Accordingly, claims 1-22 and 33-48 are deemed to be in condition for allowance, and such allowance is respectfully requested.

Respectfully Submitted,

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